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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

[10191/1917]

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OFFICE OF PETITIONS

Applicant(s) : Hans-Joerg MAHONY et al.
Serial No. : 09/960,571
Filed : September 21, 2001
For : DEVICE FOR CONTROLLING/REGULATING THE
OPERATIONAL SEQUENCES IN A MOTOR VEHICLE
Examiner : Crystal J. Barnes
Group Art Unit : 2121
Confirmation No. : 5723

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**SECOND REQUEST FOR RECONSIDERATION OF DECISION
TO DISMISS REQUEST TO ACCORD A FILING DATE
OF SEPTEMBER 12, 2001, PETITION AND STATEMENT
UNDER 37 C.F.R. § 1.6(e) AND PETITION UNDER 37 C.F.R. § 1.183**

Sir:

This Second Request for Reconsideration is being filed in response to the Decision Dismissing Petition ("the Decision") dated April 16, 2004, in which Applicants' "Request for Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition Under 37 C.F.R. § 1.183" ("the First Request for Reconsideration") was dismissed. In addition to explaining why Applicants have fully complied with the requirements of 37 C.F.R. § 1.6(e) ("the Rule") in promptly filing the application papers for which a filing date of September 12, 2001 is sought, i.e., the four pages of Specification, one sheet of five claims, one sheet of Abstract and two sheets of drawings, after the ending of the postal service interruption, Applicants are also submitting sufficient evidence to show: (1) that as of June 1, 2001, Kenyon & Kenyon, counsel for Robert Bosch GmbH, assignee of the entire right, title and interest in and to the above-captioned application by virtue of an assignment recorded in the records of the United States Patent and Trademark Office ("the USPTO") on February 12, 2002 at Reel 012619,

Frame 0821, was in possession of a copy of German Application No. 100 44 934.4 to which the above-caption application claims priority; (2) that the application papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings, for which a filing date of September 12, 2001 is sought and that were mailed on September 21, 2001 were prepared and in final printed form as of September 4, 2001; (3) that the transmittal form that was mailed on September 21, 2001 was prepared and in final printed form as of September 5, 2001; and (4) that but for the postal service interruption caused by the World Trade Center attacks, the application papers for which a filing date of September 12, 2001 is sought would have been filed no later than September 12, 2001. Applicants therefore respectfully request reconsideration of the Decision dismissing the First Request for Reconsideration and hereby respectfully request and petition that the present application be accorded a filing date of September 12, 2001. In the alternative, Applicants hereby petition under 37 C.F.R. § 1.183 for suspension or waiver of the alleged requirements of the Rule so that a filing date of September 12, 2001 can be accorded to the present application.

ARGUMENT

In the Decision, the USPTO acknowledges that Applicants have met two of the three requirements of the Rule. That is, the USPTO acknowledges the existence of a postal service interruption that was designated as such by the Commissioner and acknowledges that Applicants promptly filed the application papers after the ending of the postal service interruption. As for the third requirement, there is disagreement between the USPTO and Applicants over what this requirement entails. The USPTO contends that Applicants are obliged to submit proof showing that "the application papers [were] complete and ready to be deposited with the USPS on the filing date requested by applicants, and [that] the complete application papers could not be deposited with the USPS for the sole reason that the postal service was not available due to the interruption or emergency designated by the Office." Decision at p. 2. Applicants, on the other hand, contend that the Rule requires no such proof, since by its very words the Rule merely requires that "the correspondence is to be accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service."

According to the USPTO, the justification for requiring this proof arises from 35 U.S.C. § 21(a) ("the Statute"). Applicants respectfully disagree. The Statute specifically states that "[t]he Director may by rule prescribe that any paper or fee required to be filed in the [USPTO] will be considered filed in the [USPTO] on the date on which it . . . would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director." The express words of the statute do not impose on Applicants the obligation to submit proof that the USPTO believes is there. The Statute is an enabling piece of legislation that merely authorizes the Director to prescribe rules governing the process by which papers submitted after a particular date will be considered filed as of that date. The Statute imposes no substantive requirements whatsoever on Applicants, since neither patent applicants nor any individual other than the Director are mentioned in the Statute. Instead, the Statute is concerned only with the powers of the Director in the area of filing dates and dates for taking action. In particular, the Statute states that "[t]he Director may by rule prescribe" the manner by which "any paper . . . will be considered filed in the Office" (emphasis added). The use of the permissive "may" and mandatory "will" in this manner indicates that Congress intended to leave it up to the Director to decide how applicants can show entitlement to a filing date that is earlier than the actual date of receipt at the USPTO or mailing by applicants. This interpretation finds support in the legislative history of the Statute, reproduced below:

A new subsection (a) has been added to section 21 of title 35 to authorize, but not require, the [Director] to give as the filing date of any paper or fee which is required to be filed in the Patent and Trademark Office the date on which the paper or fee was deposited with the United States Postal Service. The Commissioner may also give as the filing date of any paper or fee which was required to be filed in the Patent and Trademark Office the date it would have been deposited with the United States Postal Service but for postal service interruptions or emergencies which the [Director] designates. The requirements governing whether any given paper or fee may be given the filing date of the day on which it was, or would have been, deposited with the United States Postal Service will be set forth in regulations established by the [Director].

H.R. Rep. 97-542, 1982 U.S.C.C.A.N. 765, 775 (insertions added) (emphasis added). The Statute itself imposes no requirements whatsoever on patent

applicants, since the purpose of the Statute is to “authorize” the Director to give as the filing date of papers or fees the date such papers or fees were actually, or would have been, deposited with the United States Postal Service. As expressly stated in the legislative history quoted above, “the requirements governing whether any given paper or fee may be given the filing date of the day on which it was, or would have been, deposited with the United States Postal Service will be set forth in regulations established by the [Director].” *Id.* Congress thus left it to the discretion of the Director to decide whether to impose on patent applicants the requirement of proof that is now claimed by the USPTO to exist. In promulgating the Rule, the Director could have opted for a mandatory proof requirement, but the Director chose not to. Instead, the Director decided to merely require that Applicants submit a statement indicating that such correspondence would have been filed on a particular date if it were not for the designated interruption or emergency in the United States Postal Service. Quite simply, the Statute does not support the requirement that the USPTO seeks to impose on Applicants.

Analogous to the wording of the Rule is that of 37 C.F.R. § 1.137(b), which sets forth the procedure for petitioning for revival of an application unintentionally abandoned. Section 1.137(b) provides that a “grantable petition . . . must be accompanied by [a] statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition . . . was unintentional.” Interestingly, 37 C.F.R. § 1.137(b) reserves the USPTO’s authority to “require additional information where there is a question whether the delay was unintentional.” In stark contrast, the Rule does not include any such reservation. Also in stark contrast to 37 C.F.R. § 1.137(b) and the Rule is 37 C.F.R. § 1.137(a), which sets forth the procedure for petitioning for revival of an application unavoidably abandoned. In this regard, 37 C.F.R. § 1.137(a) requires “[a] **showing to the satisfaction of the Director** that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition . . . was unavoidable” (emphasis added). Since the enactment of the Statute, the Director has had the authority to establish a rule that requires or reserves the USPTO’s authority to require additional information as to whether certain correspondence would have been filed on a particular date if it were not for a designated interruption or emergency in the United States Postal Service, and the Director has had the authority to establish a rule that requires a showing -- as distinct from a statement --

that certain correspondence would have been filed on a particular date if it were not for a designated interruption or emergency in the United States Postal Service. To date, the Director has not exercised this authority.

As further regards the "statement" required under 37 C.F.R. § 1.137(b) -- as distinct from a "showing" such as that required under 37 C.F.R. § 1.137(a) -- the M.P.E.P. provides the following guidance:

Petitions under 37 CFR 1.137(b) are less burdensome (statement(s) rather than a showing accompanied by documentary evidence) to file

While the Office reserves the authority to require further information concerning the cause of abandonment and delay in filing a petition to revive, the Office relies upon the applicant's duty of candor and good faith and accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR 1.137(b). This is because the applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. . . .

Even if the Office requires further information in a petition under 37 CFR 1.137(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether "the entire delay . . . was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP §§ 711.03(c)(III)(C)(2). In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37 CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR 1.137(a).

Since the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to be grantable as filed than is a petition under 37 CFR 1.137(b). The Office usually must render a number of

interlocutory decisions dismissing a petition under 37 CFR 1.137(a) and requesting additional evidence until either the applicant provides a satisfactory showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR 1.137(a) than it would have been if the petition were under 37 CFR 1.137(b).

As indicated above, the M.P.E.P. makes plain the distinction between a statement -- such as that required under the Rule and 37 C.F.R. § 1.137(b) -- and a showing -- such as that required under 37 C.F.R. § 1.137(a). Since the Rule merely requires a "statement," as opposed to a "showing," it is respectfully submitted that the statement contained in the "Statement Under 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e)," filed on September 21, 2001 that "[t]he attached correspondence would have been timely filed on **September 12, 2001** if it were not for the U.S. Postal Service interruption and emergency" (emphasis added) fully satisfies the "statement" requirement of the Rule.

Thus, it is maintained and respectfully submitted that the Rule merely requires that the correspondence be "[p]romptly filed after the ending of the designated interruption or emergency" and that the correspondence be "[a]ccompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service." The Rule requires nothing more.

For clarification purposes, Applicants do not dispute that the transmittal was signed on September 21, 2001. Rather, Applicants only seek to have a filing date of September 12, 2001 accorded to the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on September 21, 2001. In this regard, it is noted that a complete application under 35 U.S.C. § 111(a) and 37 C.F.R. § 1.53(b) merely requires: (1) a specification containing a description pursuant to 37 C.F.R. § 1.71; (2) at least one claim pursuant to 37 C.F.R. § 1.75; and (3) any drawing referred to in the specification or required by 37 C.F.R. § 1.81(a). The four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on

September 21, 2001 constitute a complete application in compliance with 35 U.S.C. § 111(a) and 37 C.F.R. § 1.53(b), and it is for only these papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on September 21, 2001, for which a filing date of September 12, 2001 is sought.

In the interest of facilitating the prosecution of this application, Applicants are submitting herewith a "Second Statement of Dervis Magistre in Support of Request For Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition Under 37 C.F.R. § 1.183" ("the Second Statement of Dervis Magistre"). Attached to the Second Statement of Dervis Magistre as Exhibit A is a copy of a letter dated May 30, 2001 from the assignee, Robert Bosch GmbH, to Kenyon & Kenyon that establishes that Kenyon & Kenyon had possession of a copy of the German priority application, i.e., German Application No. 100 44 934.4, prior to September 12, 2001, the filing date requested. The letter, which is dated May 30, 2001, instructs Kenyon & Kenyon to file a United States patent application based on German Application No. 100 44 934.4, which was filed in the Federal Republic of Germany on September 12, 2000. The bottom of the letter indicates that a copy of the German priority application was enclosed. The back side of the letter includes a Kenyon & Kenyon time stamp indicating that the letter and application were received on June 1, 2001, at 2:30 P.M.

Furthermore, the Second Statement of Dervis Magistre is believed to provide sufficient document evidence to set forth that the application papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings, that were deposited with the United States Postal Service on September 21, 2001 and for which a filing date of September 12, 2001 is sought, were complete and ready to be deposited with the United States Postal Service on the filing date requested by Applicants, i.e., on September 12, 2001.

The word processor documents that contain the Specification, claims and Abstract of this application and the transmittal form for this application are maintained by Kenyon & Kenyon in an electronic document management system, namely, "iManage infoRite." Exhibit B to the Second Statement of Dervis Magistre is a printed record of activity history related to the word processor document that contains the Specification, claims and Abstract of this application, and Exhibit C to the Second Statement of Dervis Magistre is a printed record of activity history

related to the word processor document that contains the transmittal form for this application.

With respect to the word processor document that contains the Specification, claims and Abstract of this application, it can be seen in Exhibit B that this word processing document was created on July 11, 2001 and printed for the last time before the requested September 12, 2001 filing date on August 31, 2001. The first activity in this word processing document after September 12, 2001 occurred on October 17, 2001. That is, the word processor document that contains the Specification, claims and Abstract of this application was not accessed, modified or even printed between September 12, 2001, i.e., the filing date sought, and September 21, 2001, i.e., the date the application papers were mailed. Thus, it is believed and respectfully submitted that Exhibit B establishes that the Specification, claims and Abstract for which a filing date of September 12, 2001 is sought were "complete and ready to be deposited with the USPS on the filing date requested by [Applicants]," i.e., on September 12, 2001. Document activity that occurred after October 17, 2001 has been redacted from Exhibit B since such document activity is not relevant to the issue of whether the Specification, claims and Abstract were "complete and ready to be deposited with the USPS" on September 12, 2001.

With respect to the word processor document that contains the transmittal form of this application, it can be seen in Exhibit C that this word processing document was created on August 1, 2001 and printed for the last time before the requested September 12, 2001 filing date on September 5, 2001. The first activity in this word processing document after September 12, 2001 occurred on September 21, 2001. However, the word processor document that contains the transmittal form was merely copied but not printed or modified on September 21, 2001 and not printed or modified between September 12, 2001, i.e., the filing date sought, and September 21, 2001, i.e., the date the application papers were mailed. Thus, it is believed and respectfully submitted that Exhibit C further establishes that the present application was "complete and ready to be deposited with the USPS on the filing date requested by [Applicants]," i.e., on September 12, 2001. Document activity that occurred after September 23, 2001 has been redacted from Exhibit C since such document activity is not relevant to the issue of whether the present application was "complete and ready to be deposited with the USPS" on September 12, 2001.

Attached as Exhibit D to the Second Statement of Dervis Magistre is a copy of a letter dated September 4, 2001 from Kenyon & Kenyon to the assignee Robert Bosch GmbH, and attached as Exhibit E to the Second Statement of Dervis Magistre is an English-language translation of the German-language letter of Exhibit D. The letter states, in pertinent part, that "a copy of a U.S. Application prepared . . . on the basis of . . . German Application [No. 100 44 934.4]" was enclosed with the letter and that the "Application [will be filed] with the [USPTO] by the due date," i.e., by the September 12, 2001, the one-year convention date from the September 12, 2000 filing date of German Application No. 100 44 934.4. It is believed and respectfully submitted that the letter attached as Exhibit D to the Second Statement of Dervis Magistre further establishes that the application papers for which a filing date of September 12, 2001 are sought were "complete and ready to be deposited with the USPS on" September 12, 2001.

Because counsel for assignee, Robert Bosch GmbH, was in possession, as of June 1, 2001, of a copy of the German priority application, and because the application papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on September 21, 2001 were prepared and in final printed form as of September 4, 2001 -- the date that a copy of the application was mailed to assignee, Robert Bosch GmbH -- and because the transmittal form mailed on September 21, 2001 was prepared and in final printed form as of September 5, 2001, Applicants respectfully submit that the application papers for which a filing date of September 12, 2001 is sought, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawing, would have been deposited on September 12, 2001 if it were not for the designated interruption or emergency in the United States Postal Service. Furthermore, while Applicants maintain that neither the Rule nor the Statute requires that "the application papers being filed must be complete and ready to be deposited with the USPS on the filing date requested by application," it is respectfully submitted that the Second Statement of Dervis Magistre, the exhibits thereto and the statements contained herein make plain that the application papers for which a filing date of September 12, 2001 is sought, i.e., the four pages of Specification, one page containing five claims, one page of Abstract and two sheets of drawings, were

complete and ready to be deposited with the United States Postal Service on September 12, 2001.

In view of the foregoing, it is respectfully submitted that Applicants have fully complied with the requirements set forth in the Rule, namely, that the correspondence be "[a]ccompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service." In this regard, Applicants restate that the application papers, particularly, the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings, that were mailed on September 21, 2001 would have been timely filed on **September 12, 2001** if it were not for the designated interruption or emergency in the United States Postal Service. Since Applicants have fully complied with the letter of the Rule, as well as with the spirit and scope of the Rule, it is again respectfully submitted that the USPTO ***must*** accord the present application a filing date of **September 12, 2001** as required by the Rule. The dismissal of the "First Request for Reconsideration" is believed to be an agency action that is arbitrary, capricious and/or an abuse of discretion and is believed to be an agency action that fails to comply with procedural requirements.

Moreover, even if the USPTO is correct in its belief that the Statute imposes on Applicants an obligation to submit evidence to show that the application would have been filed on September 12, 2001, but for the postal interruption -- which Applicants do not concede -- it is respectfully submitted that Applicants have met this requirement by providing sufficient evidence to show that a copy of the German priority application was in the possession of counsel for assignee, Robert Bosch GmbH, before the requested filing date of September 12, 2001 and the application papers for which a filing date of September 12, 2001 is sought, *i.e.*, the four pages of Specification, one page containing five claims, one page of Abstract and two sheets of drawings, were prepared and in final printed form before the requested filing date of September 12, 2001. Accordingly, Applicants again request that the above-referenced application be accorded the filing date of September 12, 2001.

In the alternative, Applicants respectfully petition under 37 C.F.R. § 1.183 for suspension or waiver of the alleged requirements of the Rule. It is respectfully submitted that the World Trade Center attacks of September 11, 2001,

which directly precipitated Applicants' inability and failure to deposit the application papers with the United States Postal Service on the filing date requested, i.e., September 12, 2001, constitute "an extraordinary situation" under 37 C.F.R. § 1.183, and it is respectfully submitted that justice requires that the USPTO accord a filing date of September 12, 2001 to the present application. Since, as indicated above, the Statute imposes no obligation whatsoever on Applicants, granting of a petition under 37 C.F.R. § 1.183 would not require suspension or waiver of any statutory requirement. That is, granting of a petition under 37 C.F.R. § 1.183 would not violate any requirement of the Statute, which merely permits the Director to prescribe a rule under which certain correspondence may be considered timely filed. Applicants therefore respectfully petition under 37 C.F.R. § 1.183 that the alleged requirements of the Rule be suspended or waived so that a filing date of September 12, 2001 can be accorded to the present application and that a filing date of September 12, 2001 be accorded to the present application. No suspension or waiver of any statutory requirement is believed to be necessary to grant relief under 37 C.F.R. § 1.183 since, as indicated above, the Statute merely authorizes the Director to promulgate a rule and does not impart any obligation to Applicants.

The Commissioner is authorized to charge any fees that may be required in accordance with this paper to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated:

6/7/04

By:



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APR 06 2004

OFFICE OF PETITIONS

In re Application of
Hans-Joerg Mathony
Application No. 09/960,571
Filed: September 21, 2001
Attorney Docket No. 10191/1917

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: **DECISION DISMISSING**
: **PETITION**
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This is a decision on the "Request for Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition Under 37 C.F.R. § 1.183" filed February 19, 2004, again requesting that the above-identified application be accorded a filing date of September 12, 2001.

A request that the above-identified application be accorded a filing date of September 12, 2001, was submitted with the application papers on filing. A decision dismissing the request was mailed on December 18, 2003. On February 19, 2004, the present request for reconsideration and petition (hereinafter referred to as petition) was filed.

37 CFR 1.6(e) states that:

If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

- (1) Promptly filed after the ending of the designated interruption or emergency; and
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

35 U.S.C. 21(a) states that:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated

by the Director. (Emphasis added.)

In the previous decision, it was acknowledged that the U.S. Patent and Trademark Office (Office) designated the interruption in the service of the USPS in the borough of Manhattan as a postal service interruption and emergency within the meaning of 35 U.S.C. 21(a), with the provisions of 37 CFR 1.6(e) in effect, and also designated the interruption in the Express Mail service of the USPS as a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e). See "United States Postal Service Interruptions", 1251 *Off. Gaz. Pat. Office* 55 (October 9, 2001).

As stated in the prior decision, the statute requires that the correspondence being filed in the Office would have been deposited with the United States Postal Service (USPS) but for **postal service** interruptions or emergencies. Thus, the statute requires that: (1) the application papers being filed must be complete and ready to be deposited with the USPS on the filing date requested by applicants, and (2) the complete application papers could not be deposited with the USPS for the **sole reason** that the postal service was not available due to the interruption or emergency designated by the Office.

Petitioner disagrees with this statement as to what the statute requires and argues that the request fully complies with the requirements of 35 U.S.C. 21(a) and 37 CFR 1.6(e). Petitioner argues that the statute does not impose any substantive requirements on applicants and that the language of the statute "indicates that Congress intended to leave it up to the Director to decide how applicants can show entitlement to a filing date earlier than the actual date of receipt." Petitioner cites the legislative history for support. Petitioner further argues that 37 CFR 1.6(e) merely requires applicant to submit "a statement indicating that such correspondence would have been filed on a particular date if it were not for the designated interruption or emergency in the United States Postal Service." Since such a statement has been submitted, petitioner argues that the Office must accord the application a filing date of September 12, 2001.

The Office does not have the authority to promulgate rules that would exceed its statutory authority. Thus, the Office can only accord a filing date under 37 CFR 1.6(e) where the requirements of 35 U.S.C. 21(a) have been met, namely, that the correspondence would have been deposited with the United States Postal Service but for the postal service interruption or emergency designated by the Director. Where the Office has reason to believe that a statement under 37 CFR 1.6(e) may not be true, it has the inherent authority to question the statement to determine whether the applicant is, in fact, entitled to the requested filing date under 35 U.S.C. 21(a) and 37 CFR 1.6(e). In this case, there is evidence that clearly contradicts the statement that was made on filing since the transmittal letter for the application was dated September 21, 2001.

The previous decision noted that the transmittal letter for the application was dated September 21, 2001, and stated that it did not appear that the application was prepared and ready to be deposited

with the USPS on September 12, 2001. The request for reconsideration fails to address this issue. The fact that the applicants' attorney's office was inaccessible to the attorney on September 12, 2001, due to the World Trade Center attack and the attorney was diligent in filing the application papers once his office resumed its normal operations would not be sufficient to establish that the application was ready to be deposited with the USPS on September 12, 2001. The record shows that the transmittal letter for the application was dated September 21, 2001. The Office simply cannot accept applicant's statement when the evidence contradicts the statement and applicants have not provided an adequate explanation or additional evidence to show that the application papers were complete and ready to be deposited with the USPS on September 12, 2001.

The petition was accompanied by a "Statement of Dervis Magistre..." in which Mr. Magistre states that he "was personally responsible for preparing the above-captioned application for filing in the United States Patent and Trademark Office" and he "had completed the application papers, i.e., the four pages of Specification, the one page containing five claims, the one page of Abstract, and the two pages of Figures, that were deposited with the United States Postal Service on September 21, 2001, no later than September 12, 2001."

The statement of Mr. Magistre was made approximately two years and five months after the application was filed. No objective evidence to corroborate Mr. Magistre's statement that he completed the application papers that were deposited with the USPS on September 21, 2001, no later than September 12, 2001, has been submitted. It is unclear how an individual involved in the day-to-day preparations of papers for filing in the USPTO can recall exactly what papers were completed by "no later than" a particular date when those papers were prepared approximately two years and five months earlier.

In the alternative, petitioner requests that the "alleged requirements of 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e) be suspended or waived so that a filing date of September 12, 2001 can be accorded to the present application." Petitioner argues that the events of September 11, 2001, constitute "an extraordinary situation" under 37 C.F.R. § 1.183, and justice requires that the Office accord a filing date of September 12, 2001 to the present application.

37 CFR 1.183 states, in part, that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party subject to such other requirements as may be imposed. (Emphasis Added.)

As noted above, the statute requires that the correspondence being filed in the Office would have been deposited with the United States Postal Service (USPS) but for postal service interruptions or emergencies. 37 CFR 1.183 does not give the Office the authority to waive a requirement of

the statute. Therefore, the petition under 37 CFR 1.183 cannot be granted.

It is again noted that the application includes a claim for foreign priority based on a German application filed September 12, 2000. An applicant may delay action until the end of the time period for taking action, but are acting at their own peril when doing so. See Ziegler et al. v. Baxter et al. v. Natta et al., 159 USPQ 378 (ComrPats 1968). Since the above-identified application has been accorded a filing date of September 21, 2001, which is more than one year after the filing date of the German application, the claim for foreign priority **cannot** be accepted. Office records have been corrected accordingly. A corrected filing receipt is attached.

The previous decision has been reconsidered as requested. The result, however, is the same.

In view of the above, the petition is dismissed.

Any request for reconsideration should be filed within **TWO MONTHS** of this decision in order to be considered timely (see 37 CFR 1.181(f)) and should be directed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

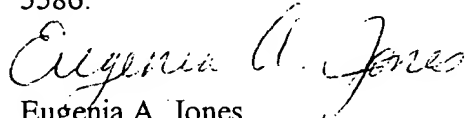
By FAX: (703) 872-9306
 Attn: Eugenia Jones
 Office of Patent Legal Administration

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window, Mail Stop Petition
 Crystal Plaza Two, Lobby, Room 1B03
 Arlington, VA 22202

Applicant is cautioned, however, that any further request for reconsideration that fails to address the issue of why the transmittal letter is dated September 21, 2001, may be considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704. See "Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term", Final Rule, 65 Fed. Reg. 56365, 56371 (Sept. 18, 2000).

The application is being returned to Technology Center 2100.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 306-5586.

A handwritten signature in cursive script, appearing to read "Eugenia A. Jones".

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Corrected Filing Receipt



[10191/1917]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Hans-Joerg MAHONY et al.
Serial No. : 09/960,571
Filed : September 21, 2001
For : DEVICE FOR CONTROLLING/REGULATING THE
OPERATIONAL SEQUENCES IN A MOTOR VEHICLE
Examiner : Crystal J. Barnes
Group Art Unit : 2121
Confirmation No. : 5723

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**SECOND REQUEST FOR RECONSIDERATION OF DECISION
TO DISMISS REQUEST TO ACCORD A FILING DATE
OF SEPTEMBER 12, 2001, PETITION AND STATEMENT
UNDER 37 C.F.R. § 1.6(e) AND PETITION UNDER 37 C.F.R. § 1.183**

Sir:

This Second Request for Reconsideration is being filed in response to the Decision Dismissing Petition ("the Decision") dated April 16, 2004, in which Applicants' "Request for Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition Under 37 C.F.R. § 1.183" ("the First Request for Reconsideration") was dismissed. In addition to explaining why Applicants have fully complied with the requirements of 37 C.F.R. § 1.6(e) ("the Rule") in promptly filing the application papers for which a filing date of September 12, 2001 is sought, i.e., the four pages of Specification, one sheet of five claims, one sheet of Abstract and two sheets of drawings, after the ending of the postal service interruption, Applicants are also submitting sufficient evidence to show: (1) that as of June 1, 2001, Kenyon & Kenyon, counsel for Robert Bosch GmbH, assignee of the entire right, title and interest in and to the above-captioned application by virtue of an assignment recorded in the records of the United States Patent and Trademark Office ("the USPTO") on February 12, 2002 at Reel 012619,

Frame 0821, was in possession of a copy of German Application No. 100 44 934.4 to which the above-caption application claims priority; (2) that the application papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings, for which a filing date of September 12, 2001 is sought and that were mailed on September 21, 2001 were prepared and in final printed form as of September 4, 2001; (3) that the transmittal form that was mailed on September 21, 2001 was prepared and in final printed form as of September 5, 2001; and (4) that but for the postal service interruption caused by the World Trade Center attacks, the application papers for which a filing date of September 12, 2001 is sought would have been filed no later than September 12, 2001. Applicants therefore respectfully request reconsideration of the Decision dismissing the First Request for Reconsideration and hereby respectfully request and petition that the present application be accorded a filing date of September 12, 2001. In the alternative, Applicants hereby petition under 37 C.F.R. § 1.183 for suspension or waiver of the alleged requirements of the Rule so that a filing date of September 12, 2001 can be accorded to the present application.

ARGUMENT

In the Decision, the USPTO acknowledges that Applicants have met two of the three requirements of the Rule. That is, the USPTO acknowledges the existence of a postal service interruption that was designated as such by the Commissioner and acknowledges that Applicants promptly filed the application papers after the ending of the postal service interruption. As for the third requirement, there is disagreement between the USPTO and Applicants over what this requirement entails. The USPTO contends that Applicants are obliged to submit proof showing that "the application papers [were] complete and ready to be deposited with the USPS on the filing date requested by applicants, and [that] the complete application papers could not be deposited with the USPS for the sole reason that the postal service was not available due to the interruption or emergency designated by the Office." Decision at p. 2. Applicants, on the other hand, contend that the Rule requires no such proof, since by its very words the Rule merely requires that "the correspondence is to be accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service."

According to the USPTO, the justification for requiring this proof arises from 35 U.S.C. § 21(a) ("the Statute"). Applicants respectfully disagree. The Statute specifically states that "[t]he Director may by rule prescribe that any paper or fee required to be filed in the [USPTO] will be considered filed in the [USPTO] on the date on which it . . . would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director." The express words of the statute do not impose on Applicants the obligation to submit proof that the USPTO believes is there. The Statute is an enabling piece of legislation that merely authorizes the Director to prescribe rules governing the process by which papers submitted after a particular date will be considered filed as of that date. The Statute imposes no substantive requirements whatsoever on Applicants, since neither patent applicants nor any individual other than the Director are mentioned in the Statute. Instead, the Statute is concerned only with the powers of the Director in the area of filing dates and dates for taking action. In particular, the Statute states that "[t]he Director may by rule prescribe" the manner by which "any paper . . . will be considered filed in the Office" (emphasis added). The use of the permissive "may" and mandatory "will" in this manner indicates that Congress intended to leave it up to the Director to decide how applicants can show entitlement to a filing date that is earlier than the actual date of receipt at the USPTO or mailing by applicants. This interpretation finds support in the legislative history of the Statute, reproduced below:

A new subsection (a) has been added to section 21 of title 35 to authorize, but not require, the [Director] to give as the filing date of any paper or fee which is required to be filed in the Patent and Trademark Office the date on which the paper or fee was deposited with the United States Postal Service. The Commissioner may also give as the filing date of any paper or fee which was required to be filed in the Patent and Trademark Office the date it would have been deposited with the United States Postal Service but for postal service interruptions or emergencies which the [Director] designates. The requirements governing whether any given paper or fee may be given the filing date of the day on which it was, or would have been, deposited with the United States Postal Service will be set forth in regulations established by the [Director].

H.R. Rep. 97-542, 1982 U.S.C.C.A.N. 765, 775 (insertions added) (emphasis added). The Statute itself imposes no requirements whatsoever on patent

applicants, since the purpose of the Statute is to “authorize” the Director to give as the filing date of papers or fees the date such papers or fees were actually, or would have been, deposited with the United States Postal Service. As expressly stated in the legislative history quoted above, “the requirements governing whether any given paper or fee may be given the filing date of the day on which it was, or would have been, deposited with the United States Postal Service will be set forth in regulations established by the [Director].” *Id.* Congress thus left it to the discretion of the Director to decide whether to impose on patent applicants the requirement of proof that is now claimed by the USPTO to exist. In promulgating the Rule, the Director could have opted for a mandatory proof requirement, but the Director chose not to. Instead, the Director decided to merely require that Applicants submit a statement indicating that such correspondence would have been filed on a particular date if it were not for the designated interruption or emergency in the United States Postal Service. Quite simply, the Statute does not support the requirement that the USPTO seeks to impose on Applicants.

Analogous to the wording of the Rule is that of 37 C.F.R. § 1.137(b), which sets forth the procedure for petitioning for revival of an application unintentionally abandoned. Section 1.137(b) provides that a “grantable petition . . . must be accompanied by [a] statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition . . . was unintentional.” Interestingly, 37 C.F.R. § 1.137(b) reserves the USPTO’s authority to “require additional information where there is a question whether the delay was unintentional.” In stark contrast, the Rule does not include any such reservation. Also in stark contrast to 37 C.F.R. § 1.137(b) and the Rule is 37 C.F.R. § 1.137(a), which sets forth the procedure for petitioning for revival of an application unavoidably abandoned. In this regard, 37 C.F.R. § 1.137(a) requires “[a] **showing to the satisfaction of the Director** that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition . . . was unavoidable” (emphasis added). Since the enactment of the Statute, the Director has had the authority to establish a rule that requires or reserves the USPTO’s authority to require additional information as to whether certain correspondence would have been filed on a particular date if it were not for a designated interruption or emergency in the United States Postal Service, and the Director has had the authority to establish a rule that requires a showing -- as distinct from a statement --

that certain correspondence would have been filed on a particular date if it were not for a designated interruption or emergency in the United States Postal Service. To date, the Director has not exercised this authority.

As further regards the "statement" required under 37 C.F.R. § 1.137(b) -- as distinct from a "showing" such as that required under 37 C.F.R. § 1.137(a) -- the M.P.E.P. provides the following guidance:

Petitions under 37 CFR 1.137(b) are less burdensome (statement(s) rather than a showing accompanied by documentary evidence) to file

While the Office reserves the authority to require further information concerning the cause of abandonment and delay in filing a petition to revive, the Office relies upon the applicant's duty of candor and good faith and accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR 1.137(b). This is because the applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. . . .

Even if the Office requires further information in a petition under 37 CFR 1.137(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether "the entire delay . . . was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP §§ 711.03(c)(III)(C)(2). In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37 CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR 1.137(a).

Since the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to be grantable as filed than is a petition under 37 CFR 1.137(b). The Office usually must render a number of

interlocutory decisions dismissing a petition under 37 CFR 1.137(a) and requesting additional evidence until either the applicant provides a satisfactory showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR 1.137(a) than it would have been if the petition were under 37 CFR 1.137(b).

As indicated above, the M.P.E.P. makes plain the distinction between a statement -- such as that required under the Rule and 37 C.F.R. § 1.137(b) -- and a showing -- such as that required under 37 C.F.R. § 1.137(a). Since the Rule merely requires a "statement," as opposed to a "showing," it is respectfully submitted that the statement contained in the "Statement Under 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e)," filed on September 21, 2001 that "[t]he attached correspondence would have been timely filed on **September 12, 2001** if it were not for the U.S. Postal Service interruption and emergency" (emphasis added) fully satisfies the "statement" requirement of the Rule.

Thus, it is maintained and respectfully submitted that the Rule merely requires that the correspondence be "[p]romptly filed after the ending of the designated interruption or emergency" and that the correspondence be "[a]ccompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service." The Rule requires nothing more.

For clarification purposes, Applicants do not dispute that the transmittal was signed on September 21, 2001. Rather, Applicants only seek to have a filing date of September 12, 2001 accorded to the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on September 21, 2001. In this regard, it is noted that a complete application under 35 U.S.C. § 111(a) and 37 C.F.R. § 1.53(b) merely requires: (1) a specification containing a description pursuant to 37 C.F.R. § 1.71; (2) at least one claim pursuant to 37 C.F.R. § 1.75; and (3) any drawing referred to in the specification or required by 37 C.F.R. § 1.81(a). The four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on

September 21, 2001 constitute a complete application in compliance with 35 U.S.C. § 111(a) and 37 C.F.R. § 1.53(b), and it is for only these papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on September 21, 2001, for which a filing date of September 12, 2001 is sought.

In the interest of facilitating the prosecution of this application, Applicants are submitting herewith a "Second Statement of Dervis Magistre in Support of Request For Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition Under 37 C.F.R. § 1.183" ("the Second Statement of Dervis Magistre"). Attached to the Second Statement of Dervis Magistre as Exhibit A is a copy of a letter dated May 30, 2001 from the assignee, Robert Bosch GmbH, to Kenyon & Kenyon that establishes that Kenyon & Kenyon had possession of a copy of the German priority application, i.e., German Application No. 100 44 934.4, prior to September 12, 2001, the filing date requested. The letter, which is dated May 30, 2001, instructs Kenyon & Kenyon to file a United States patent application based on German Application No. 100 44 934.4, which was filed in the Federal Republic of Germany on September 12, 2000. The bottom of the letter indicates that a copy of the German priority application was enclosed. The back side of the letter includes a Kenyon & Kenyon time stamp indicating that the letter and application were received on June 1, 2001, at 2:30 P.M.

Furthermore, the Second Statement of Dervis Magistre is believed to provide sufficient document evidence to set forth that the application papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings, that were deposited with the United States Postal Service on September 21, 2001 and for which a filing date of September 12, 2001 is sought, were complete and ready to be deposited with the United States Postal Service on the filing date requested by Applicants, i.e., on September 12, 2001.

The word processor documents that contain the Specification, claims and Abstract of this application and the transmittal form for this application are maintained by Kenyon & Kenyon in an electronic document management system, namely, "iManage infoRite." Exhibit B to the Second Statement of Dervis Magistre is a printed record of activity history related to the word processor document that contains the Specification, claims and Abstract of this application, and Exhibit C to the Second Statement of Dervis Magistre is a printed record of activity history

related to the word processor document that contains the transmittal form for this application.

With respect to the word processor document that contains the Specification, claims and Abstract of this application, it can be seen in Exhibit B that this word processing document was created on July 11, 2001 and printed for the last time before the requested September 12, 2001 filing date on August 31, 2001. The first activity in this word processing document after September 12, 2001 occurred on October 17, 2001. That is, the word processor document that contains the Specification, claims and Abstract of this application was not accessed, modified or even printed between September 12, 2001, i.e., the filing date sought, and September 21, 2001, i.e., the date the application papers were mailed. Thus, it is believed and respectfully submitted that Exhibit B establishes that the Specification, claims and Abstract for which a filing date of September 12, 2001 is sought were "complete and ready to be deposited with the USPS on the filing date requested by [Applicants]," i.e., on September 12, 2001. Document activity that occurred after October 17, 2001 has been redacted from Exhibit B since such document activity is not relevant to the issue of whether the Specification, claims and Abstract were "complete and ready to be deposited with the USPS" on September 12, 2001.

With respect to the word processor document that contains the transmittal form of this application, it can be seen in Exhibit C that this word processing document was created on August 1, 2001 and printed for the last time before the requested September 12, 2001 filing date on September 5, 2001. The first activity in this word processing document after September 12, 2001 occurred on September 21, 2001. However, the word processor document that contains the transmittal form was merely copied but not printed or modified on September 21, 2001 and not printed or modified between September 12, 2001, i.e., the filing date sought, and September 21, 2001, i.e., the date the application papers were mailed. Thus, it is believed and respectfully submitted that Exhibit C further establishes that the present application was "complete and ready to be deposited with the USPS on the filing date requested by [Applicants]," i.e., on September 12, 2001. Document activity that occurred after September 23, 2001 has been redacted from Exhibit C since such document activity is not relevant to the issue of whether the present application was "complete and ready to be deposited with the USPS" on September 12, 2001.

Attached as Exhibit D to the Second Statement of Dervis Magistre is a copy of a letter dated September 4, 2001 from Kenyon & Kenyon to the assignee Robert Bosch GmbH, and attached as Exhibit E to the Second Statement of Dervis Magistre is an English-language translation of the German-language letter of Exhibit D. The letter states, in pertinent part, that "a copy of a U.S. Application prepared . . . on the basis of . . . German Application [No. 100 44 934.4]" was enclosed with the letter and that the "Application [will be filed] with the [USPTO] by the due date," i.e., by the September 12, 2001, the one-year convention date from the September 12, 2000 filing date of German Application No. 100 44 934.4. It is believed and respectfully submitted that the letter attached as Exhibit D to the Second Statement of Dervis Magistre further establishes that the application papers for which a filing date of September 12, 2001 are sought were "complete and ready to be deposited with the USPS on" September 12, 2001.

Because counsel for assignee, Robert Bosch GmbH, was in possession, as of June 1, 2001, of a copy of the German priority application, and because the application papers, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings that were mailed on September 21, 2001 were prepared and in final printed form as of September 4, 2001 -- the date that a copy of the application was mailed to assignee, Robert Bosch GmbH -- and because the transmittal form mailed on September 21, 2001 was prepared and in final printed form as of September 5, 2001, Applicants respectfully submit that the application papers for which a filing date of September 12, 2001 is sought, i.e., the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawing, would have been deposited on September 12, 2001 if it were not for the designated interruption or emergency in the United States Postal Service. Furthermore, while Applicants maintain that neither the Rule nor the Statute requires that "the application papers being filed must be complete and ready to be deposited with the USPS on the filing date requested by application," it is respectfully submitted that the Second Statement of Dervis Magistre, the exhibits thereto and the statements contained herein make plain that the application papers for which a filing date of September 12, 2001 is sought, i.e., the four pages of Specification, one page containing five claims, one page of Abstract and two sheets of drawings, were

complete and ready to be deposited with the United States Postal Service on September 12, 2001.

In view of the foregoing, it is respectfully submitted that Applicants have fully complied with the requirements set forth in the Rule, namely, that the correspondence be "[a]ccompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service." In this regard, Applicants restate that the application papers, particularly, the four pages of Specification, one page of five claims, one page of Abstract and two sheets of drawings, that were mailed on September 21, 2001 would have been timely filed on September 12, 2001 if it were not for the designated interruption or emergency in the United States Postal Service. Since Applicants have fully complied with the letter of the Rule, as well as with the spirit and scope of the Rule, it is again respectfully submitted that the USPTO must accord the present application a filing date of September 12, 2001 as required by the Rule. The dismissal of the "First Request for Reconsideration" is believed to be an agency action that is arbitrary, capricious and/or an abuse of discretion and is believed to be an agency action that fails to comply with procedural requirements.

Moreover, even if the USPTO is correct in its belief that the Statute imposes on Applicants an obligation to submit evidence to show that the application would have been filed on September 12, 2001, but for the postal interruption -- which Applicants do not concede -- it is respectfully submitted that Applicants have met this requirement by providing sufficient evidence to show that a copy of the German priority application was in the possession of counsel for assignee, Robert Bosch GmbH, before the requested filing date of September 12, 2001 and the application papers for which a filing date of September 12, 2001 is sought, i.e., the four pages of Specification, one page containing five claims, one page of Abstract and two sheets of drawings, were prepared and in final printed form before the requested filing date of September 12, 2001. Accordingly, Applicants again request that the above-referenced application be accorded the filing date of September 12, 2001.

In the alternative, Applicants respectfully petition under 37 C.F.R. § 1.183 for suspension or waiver of the alleged requirements of the Rule. It is respectfully submitted that the World Trade Center attacks of September 11, 2001,

which directly precipitated Applicants' inability and failure to deposit the application papers with the United States Postal Service on the filing date requested, i.e., September 12, 2001, constitute "an extraordinary situation" under 37 C.F.R. § 1.183, and it is respectfully submitted that justice requires that the USPTO accord a filing date of September 12, 2001 to the present application. Since, as indicated above, the Statute imposes no obligation whatsoever on Applicants, granting of a petition under 37 C.F.R. § 1.183 would not require suspension or waiver of any statutory requirement. That is, granting of a petition under 37 C.F.R. § 1.183 would not violate any requirement of the Statute, which merely permits the Director to prescribe a rule under which certain correspondence may be considered timely filed. Applicants therefore respectfully petition under 37 C.F.R. § 1.183 that the alleged requirements of the Rule be suspended or waived so that a filing date of September 12, 2001 can be accorded to the present application and that a filing date of September 12, 2001 be accorded to the present application. No suspension or waiver of any statutory requirement is believed to be necessary to grant relief under 37 C.F.R. § 1.183 since, as indicated above, the Statute merely authorizes the Director to promulgate a rule and does not impart any obligation to Applicants.

The Commissioner is authorized to charge any fees that may be required in accordance with this paper to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated:

6/7/04

By:



Gerard A. Messina

Reg. No. 35,952

One Broadway
New York, NY 10004
(212) 425-7200



[10191/1917]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Hans-Joerg MAHONY et al.
Serial No. : 09/960,571
Filed : September 21, 2001
For : DEVICE FOR CONTROLLING/REGULATING THE
OPERATIONAL SEQUENCES IN A MOTOR VEHICLE
Examiner : Crystal J. Barnes
Group Art Unit : 2121
Confirmation No. : 5723

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**SECOND STATEMENT OF DERVIS MAGISTRE IN SUPPORT OF
SECOND REQUEST FOR RECONSIDERATION OF DECISION TO
DISMISS REQUEST TO ACCORD A FILING DATE
OF SEPTEMBER 12, 2001 AND PETITION UNDER 37 C.F.R. § 1.183**

S I R:

I, **DERVIS MAGISTRE**, in support of the "Second Request For Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition under 37 C.F.R. § 1.183" in connection with the above-captioned application, state as follows:

1. I am associated with the law firm of Kenyon & Kenyon.
2. I was personally responsible for preparing the above-captioned application for filing in the United States Patent and Trademark Office.
3. I have reviewed the contents of the files maintained by Kenyon & Kenyon relating to this application.

ev 331381545

4. The application papers, i.e., the four pages of Specification, the one page containing five claims, the one page of Abstract, and the two pages of Figures, that were deposited with the United States Postal Service on September 21, 2001, were prepared and completed under my direction by September 4, 2001.

5. Exhibit A is a copy of a letter contained in the files of Kenyon & Kenyon related to this application dated May 30, 2001 from Robert Bosch GmbH, assignee of the entire right, title and interest in and to this application, to Kenyon & Kenyon, in which Kenyon & Kenyon was instructed to prepare and file a United States patent application based on Application No. 100 44 934.4, filed in the Federal Republic of Germany on September 12, 2000. Exhibit A states that a copy of German Application No. 100 44 934.4 was enclosed. The back side of Exhibit A indicates that the letter was received in the offices of Kenyon & Kenyon on June 1, 2001 at 2:30 p.m.

6. Exhibit B is printed copy of a history of document activity related to the word processor document that contains the four pages of Specification, one page containing five claims and one page of Abstract, for which a filing date of September 12, 2001 is requested. Exhibit B was printed from the document management system of Kenyon & Kenyon. Exhibit B indicates that the word processor document that contains the four pages of Specification, one page containing five claims and one page of Abstract for which a filing date of September 12, 2001 is sought was created on July 11, 2001 and was last printed before the mailing date of September 21, 2001 on August 31, 2001. The first event indicated in Exhibit B after the September 12, 2001 filing date requested and the mailing date of September 21, 2001 occurred on October 17, 2001. Activity in connection with this word processor document that occurred after October 17, 2001 has been redacted from Exhibit B since such document activity is not relevant to whether the present application is entitled to a filing date of September 12, 2001. In view of the foregoing, it is believed that the four pages of Specification, one page containing five claims and one page of Abstract for which a filing date of September 12, 2001 is sought was not accessed, modified or even printed between the filing date sought, i.e., September 12, 2001, and the mailing date of September 21, 2001. That is, the four pages of Specification, one page containing

five claims and one page of Abstract were complete and ready to be deposited with the United States Postal Service on September 12, 2001.

7. Exhibit C is printed copy of a history of document activity related to the word processor document that corresponds to the transmittal form of this application. Exhibit C was printed from the document management system of Kenyon & Kenyon. Exhibit C indicates that the word processor document that corresponds to the transmittal form mailed on September 21, 2001 was created on August 1, 2001 and printed for the last time before the mailing date of September 21, 2001 on September 5, 2001. Although Exhibit C indicates that the word processor document that corresponds to the transmittal form of this application was copied on September 21, 2001 and September 23, 2001, based on the indication that this word processor document was last printed on September 5, 2001, it is believed that the transmittal form mailed on September 21, 2001 was complete and ready to be deposited with the United States Postal Service on September 12, 2001.

8. Exhibit D is a copy of a letter dated September 4, 2001 from Kenyon & Kenyon to Robert Bosch GmbH, assignee of the entire right, title and interest in and to the present application. This letter was located in the files maintained by Kenyon & Kenyon that correspond to the present application.

9. Exhibit E is an English-language translation of the letter of Exhibit D. Exhibit E states that "a copy of a U.S. Application prepared . . . on the basis of . . . German Application [No. 100 44 934.4]" is provided and that "this Application [will be filed] with the [United States Patent and Trademark Office] by the due date," i.e., by the one-year convention date from September 12, 2000, i.e., September 12, 2001.

Respectfully submitted,

Dated:

6/7/04

By:


Dervis Magistre
Reg. No. 41,172
KENYON & KENYON
One Broadway
New York, NY 10004
(212) 425-7200